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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,463	04/02/2001	Geoffrey B. Rhoads	P0338	1336

23735 7590 10/20/2004  
DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/825,463

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. Claims 1-20 are pending.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 6, 9, 11-12, 14, 16, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Leighton (U.S. 5,949,885).

As per claims 1 and 11, Leighton discloses a computer device having a memory in which audio or visual content may be stored (see column 3 lines 11-30), the device including software for automatically analyzing content stored in said memory for plural-bit digital watermark data (see column 3 lines 56-67), and for altering an aspect of the device's operation with respect to said content, in accordance with detection of said watermark data (see column 6 lines 54-65).

As per claims 2 and 12, Leighton discloses the content is still image data (see column 3 lines 11-30).

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As per claims 4 and 14, Leighton discloses the software alters device operation to signal to a user a third party has proprietary rights to the content (see column 1 lines 16-33).

As per claims 6 and 16, Leighton discloses the software provides at least some of the digital watermark data to a remote database, resulting in the provision of remote information to the device that controls some aspect of its operation (see column 7 lines 36-60).

As per claims 9 and 19, Leighton discloses the software automatically reports detection of at least some of the digital watermark data to a remote computer (see column 7 lines 36-60).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton as applied to claims 1 and 11 above, and further in view of Mast (U.S. 5,881,287).

As per claims 3 and 13, Leighton fails to disclose the memory comprises a clipboard used by the device's operating system.

However, Mast teaches the use of a clipboard as memory (see column 2 lines 3-12).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to check Mast's clipboard memory with Leighton's watermark detection method.

Motivation to do so would have been that unlicensed data could be found in the clipboard memory (see Mast column 2 lines 3-12).

6. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton as applied to claims 1 and 11 above, and further in view of Saito (U.S. 6,182,218).

As per claims 5 and 15, Leighton fails to disclose the software alters a graphical display to the user to alert the user that a third party has proprietary rights to the content.

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However, Saito teaches such an alteration (see column 9 lines 3-15 and Figs 3A and 3B).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Saito's graphical alteration to the digital content Leighton's method detects.

Motivation to do so would have been to allow for notification that the user is unauthorized to store, copy, or transfer the data (see Saito column 9 lines 3-15).

7. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton as applied to claims 6 and 16 above, and further in view of Biezunski et al (webpage).

As per claims 7 and 17, Leighton fails to disclose the information being HTML instructions.

However Biezunski et al teaches the use of HTML (see page 2).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the instructions of Leighton as HTML as described in Biezunski et al.

Motivation to do so would have been because HTML is parsable (see page 2).

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8. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton as applied to claims 6 and 16 above, and further in view of Ananda (U.S. 5,495,411).

As per claims 8 and 18, Leighton discloses checking a watermark with a password to a user password (see column 8 lines 18-30), but fails to disclose sending any of this data to a remote database.

However, Ananda discloses sending a password to a database for comparison (see column 7 lines 13-37).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the watermark password of Leighton to a database as described in Ananda.

Motivation to do so would have been to allow certain users access to the content (see Ananda column 7 lines 13-37).

9. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton as applied to claims 1 and 11 above, and further in view of "Opening Windows and Frames" (webpage).

As per claims 10 and 20, Leighton fails to disclose the software, upon detection of the watermark data, causes

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a new box to be displayed on a display screen, the box presenting information to the user.

However, the webpage discloses displaying such a box (see page2 2-3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to display the box of the webpage when the software of Leighton detects a watermark.

Motivation to do so would have been to alert the user and confirm information by the user (see pages 2-3).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Venkatesan et al (U.S. 6,546,114) discloses the automatic detection of watermarks in images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell



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can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

Andrew Caldwell  
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